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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,423	12/06/2006	Benjamin Weber	1034193-000062	3245

21839 7590 03/13/2008
BUCHANAN, INGERSOLL & ROONEY PC
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ALEXANDRIA, VA 22313-1404

EXAMINER

MAI, ANH T

ART UNIT	PAPER NUMBER
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2832

NOTIFICATION DATE	DELIVERY MODE
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03/13/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/594,423	Applicant(s) WEBER ET AL.	
	Examiner Anh T. Mai	Art Unit 2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/06;12/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5-9, 11-16, 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah et al. [6873236].

Shah discloses:

- a coil having an electrical conductor in the form of a strip 12 and having at least one insulating material layer which, specifically the conductor 14 and the at least one insulating material layer 16, are wound around a winding axis in order to form turns [figure 1];
- the conductor is non- detachably connected at least on one broad face to the at least one insulating material layer as shown in figure 1 wherein radially adjacent turns are wound without any axially offset with respect to one another;
- the connection of the conductor to the at least one insulating material layer is formed over the complete area on the at least one broad face ;
- the at least one insulating material layer is applied to the conductor by means of powder coating [col 4, lines 5-10];
- wherein the conductor is non-detachably connected to a respective insulating material layer on one broad face;

- a first electrical connecting element is arranged at a radially inner and outer conductor end 18/20 as shown in figure 1;
- the conductor is arranged with its lateral direction which is at right angles to its longitudinal direction and is located in the broad face parallel to the winding axis;
- the turns of conductor are arranged around a core [col 1, lines 65-66];
- the width of the conductor corresponds to the width of the at least one insulating material layer;

With respect to claims 13-16, 18-22, the claims are method counterpart of structure claims 1-3, 5-9, 11-12 and methods steps therefore inherent for manufacturing a transformer coil comprising winding material in the form of a strip being wound around a winding axis.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah in view of Horton III [389955].

With respect to claim 4, Shah discloses the invention as claimed as cited above except for the interposition of the adhesive layer between the conductor and insulating material.

Horton discloses an interposition of the adhesive 60 between insulating sheet 58 and foil conductor 40 as shown in figure 6 [col 3, lns 40-52]. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to interpose adhesive between the conductor and insulating material layer as taught by Horton to the device as disclosed by Shah. The motivation would have been to provide additional reinforcement and coil and prevents relative movement there between. Therefore, it would have been obvious to combine Horton with Shah.

Claim 17 is rejected for reciting method/step derived from the structure of claim 1 which is rejected above.

With respect to claim 10, Shah discloses the claimed invention except for the width of the conductor being 300 mm to 1400 mm, preferably 1000 mm. It would have been an obvious matter of design choice to choose the width of the conductor, since such a modification would be functional for the final desired use or would have been involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *Concrete Unlimited Inc. V. Cementcraft Inc.* 227 USPQ 784 (Fed. Cir. 1985); *In re Kuhle* 188 USPQ 7 (CCPA 1975)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 form Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh T. Mai whose telephone number is 571-272-1995. The examiner can normally be reached on 5/4/9 Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Anh T. Mai/
Primary Examiner, Art Unit 2832

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